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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/952,001	11/07/1997	RONALD L CARR	P97194.024	2230

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EXAMINER

PICKARD, ALISON K

ART UNIT

PAPER NUMBER

3676

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	08/952,001	CARR, RONALD L
	<b>Examiner</b>	<b>Art Unit</b>
	Alison K. Pickard	3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 26 April 2002.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 55-92 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 56-58 and 88-92 is/are allowed.

6) Claim(s) 55,60-62,66-69,73-78,82-85 and 87 is/are rejected.

7) Claim(s) 59,63-65,70-72,79-81 and 86 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Upon further consideration (and discovery of Reissue 11,858), the rejection of Claim 55 is withdrawn. A new Action follows.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 55 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Merwarth (Re. 11,858).

Merwarth discloses a gasket (in Fig. 3) for providing a seal at the joint between a pair of pipe flanges D' and E comprising a first strip A formed in a loop having an outer periphery, a second strip F formed in a loop having an outer periphery greater than the first strip's, and at least one spoke C extending between the first and second strips wherein remaining spaces therebetween are substantially void. The first strip, second strip, and spoke are all formed of a sealing material (soft metal, see page 2, lines 15, 19-20, and 29-33). While Merwarth does not specify that the “soft metal” of A, F, and C are the same soft metal, it is considered inherent that they are since the strips/spoke function as seals. Further, it is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin*, (CCPA 1960). Using the same material would also provide ease in manufacturing considerations. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made

to make the first and second strips and the spokes of the same material as a matter of choice in design.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 60-62, 66-69, 73-78, and 82-84 rejected under 35 U.S.C. 103(a) as being unpatentable over Mastin, U. S. Patent No. 1,245,002 in view of Smith, U. S. Patent No. 4,002,344.

Mastin discloses a gasket similar to applicant's comprising a first strip g', a second strip j, and at least one spoke k of sealing material (see Figure 3). A third strip (the inner most loop g') having an outer periphery less than the inner periphery of the first strip and a spoke extending between the third and first strips g' can be seen in Figure 3 as well. The strips and spokes are formed of the same sealing material and "are designed to produce a hermetic seal" (page 1, lines 23-27). Mastin does not disclose open or closed alignment spokes extending from the second strip.

Smith teaches the use of open 46 and closed 51 alignment spokes which center a gasket between a variety of different sized flanges. The open spoke defines a concavity 48 and centering shelf 49. The closed spoke 51 has an aperture for a bolt and a tab portion 56 with identification data. These locators, 46 and 51, are taught to "accommodate different flange sizes, bolt circles, and bolt diameters" (col. 1, lines 35-37). Therefore, flanges with different outer peripheries

could be used so that the locator or alignment spoke is congruent with a larger outer flange while the outer or second strip is congruent with a smaller outer flange. As for making the alignment spokes out of the sealing material used for the strips and spokes, Mastin discloses using the ribs or ridges (spokes or strips) around openings to produce a hermetic seal. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include an open or closed alignment spoke as taught by Smith extending from the second strip out of the sealing material to provide a gasket which can be properly aligned between a variety of different sized flanges which would provide an efficient seal at the inner and outer edges of the flanges as well as around the bolt holes.

6. Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastin.

Mastin discloses a gasket similar to applicant's comprising a first and second strip and at least one spoke. However, Mastin's outer or second strip is not formed in a square shape. Using a square shape is considered a design choice as applicant has not stated that using a square rather than a circle solves any stated problem or is for any particular purpose. Further, it appears that the circular shape of Mastin would perform equally as well. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to form the second strip with a square shape as a matter of choice in design.

7. Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mastin as applied to claim 85 above, and further in view of Smith.

As mentioned above, Mastin does not include a closed alignment spoke which can receive a bolt. Smith teaches the use of a closed 51 alignment spoke to center a gasket between a

variety of different sized flanges. The closed spoke 51 has an aperture for a bolt. The closed spoke 51 is taught to "accommodate different flange sizes, bolt circles, and bolt diameters" (col. 1, lines 35-37). As for making the alignment spokes out of the sealing material used for the strips and spokes, Mastin has disclosed that this is desirable so as to provide a seal around the holes. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include a closed alignment spoke as taught by Smith extending from the second strip out of the sealing material to provide a gasket which can be properly aligned between a variety of different sized flanges which would provide an efficient seal at the inner and outer edges of the flanges as well as around the bolt holes.

***Allowable Subject Matter***

8. Claims 56-58 and 88-92 are allowed.
9. Claims 59, 63-65, 70-72, 79-81, and 86 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments filed 4-26-02 have been fully considered but they are not persuasive.

Upon discovery and further consideration of Merwarth Re. 11,858, a new rejection has been applied to claim 55. Merwarth '858 discloses applicant's gasket as claimed. As acknowledged by Applicant, Merwarth discloses that the rings A and F and spoke C can all be made of soft metal (see page 2 lines 15, 19-20, and 29-33). Applicant's argument that Merwarth

teaches away from making the rings A and B from the same soft metal is considered moot.

Merwarth discloses a gasket having at least one spoke extending between a first and second strip, all made of sealing material. It is considered inherent that they are all of the same material since they all function as seals. Using the same material would make manufacturing easier. Further, the specification does not state that they are different materials.

Regarding claims 60-62, 66-69, 73-78, 82-84, (and 87), Applicant has argued that modifying Mastin with Smith would not achieve the inventor's intended purpose. The Examiner disagrees. Mastin discloses a gasket with a first strip *g'*, second strip *j*, third strip *g'*, and spoke *k*. Mastin also discloses a bolt hole *i*. Mastin discloses that the strips/spokes are provided at openings (such as bore or bolt openings) to "produce a hermetic seal" (page 1, lines 23-27). Mastin does not disclose that this gasket can be used with a variety of different sized flanges. In fact, it appears that the gasket would be limited to a single size arrangement. Smith teaches open and closed alignment spokes that center a gasket between a variety of "different sized flanges, bolt circles and bolt diameters" (col. 1, lines 35-37). Smith's teachings would be applied to Mastin so the gasket can be used between a variety of different sized flanges, bolt circles or bolt diameters. Mastin already discloses that strips are provided at openings to provide a hermetic seal. Combining Mastin in view of Smith would create an improved gasket that provides a hermetic seal around all openings between a variety of different sized flanges, bolt circles and bolt diameters.

Regarding claim 85, Applicant argues that the square shape would protrude from a round pipe flange so they can be easily grasped and the gasket can be centered. However, these features are not claimed, and there is no criticality supported in the specification as to the shape,

to allow it in would be new matter. Further, it appears the specification and Figures contradict Applicant's argument. Neither Figure 14 nor 15 (the only figures showing a square strip) show corners that would project past a flange. In fact, both embodiments include the open and closed alignment spokes that aid in locating the gasket. No corners or edges would protrude past the circular flange. Applicant is arguing structure, function, and embodiments that aren't even disclosed in this application. The examiner suggests filing a C.I.P to pursue the square feature further.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 703-305-0882. The examiner can normally be reached on M-F (9-6:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-8729327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.

AP  
July 12, 2002



Anthony Knight  
Supervisory Patent Examiner  
Group 3600